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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,534	07/17/2003	Veronique Ferrari	05725.0655-01	2495
22852 7590 03/22/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER WILLIAMS, LEONARD M	
			ART UNIT	PAPER NUMBER
			1617	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/22/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/621,534	<b>Applicant(s)</b> FERRARI ET AL.	
	<b>Examiner</b> Leonard M. Williams	<b>Art Unit</b> 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.  
4a) Of the above claim(s) 43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                      | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

Detailed Action

***Priority***

The current application is a continuation of 09/618031 now abandoned.

***Election/Restrictions***

Applicant's election with traverse of Group I in the reply filed on 12/06/2006 is acknowledged. The traversal is on the ground(s) that the restriction is improper as there is no serious burden for the examiner to examine Groups I and II together. This is not found persuasive because the examiner has clearly set forth the reasons for the restriction requirement between products and process of using said products. The examiner upon further consideration does withdraw the election of species requirement set forth in the election/restriction requirement.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 5, 6, 8-12, 14, 15, 17, 25, 26, 29 and 31-42 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,849,275 (275).

US '275 is directed to cosmetic compositions containing about 0.1-70% of a copolymer, about 0.1-60 wt.% of a volatile solvent, 0.1-60 wt.% of a non-volatile oil and 0.1-80% of dry particulate matter (abstract). For silicone polymers containing methacrylic, acrylic and styrene monomers that are encompassed by the organic polymers of the instant claim 29 see column 2, line 16 to column 3, line 36. For volatile solvents see column 4, line 28 to column 5, line 13. For non-volatile solvents see the non-volatile oils at column 5, line 25 to column 6, line 23. For dyestuffs and fillers see column 6, lines 25-63. For waxes see column 7, lines 17-24. For anhydrous gels see Examples 4 and 5 at column 11. For solid compositions see face powders, blush and eyeshadow at column 8, lines 2, 45 and 58. For application to keratin materials see column 1, lines 9-10.

The examples beginning at column 9 of US '275 all contain at least one organic polymer, at least volatile solvent and at least one non-volatile solvent. Example 1 discloses a composition that contains SA-70SIBMMF (organic polymer) in a 25% solution of cyclomethicone (volatile solvent), octyldodecanol (non-volatile solvent of instant claim 17), trilaurin (a non-volatile fatty acid triglycerides encompassed by instant claim 14), vegetable oil and corn oil (non-volatile solvents encompassed by instant claim 15), isododecane and additional cyclomethicone (volatile solvents disclosed by Applicant at page 4, last paragraph of the instant specification). The other examples likewise contain various compounds that Applicant discloses as volatile and non-volatile solvents suitable for the instant invention.

Inherent properties such as the capability of a compound to increase in volume upon deposition to keratin materials, vapor pressure, glass transition temperature (T<sub>g</sub>) and the effectiveness of the composition to perform the functions of claim 40 are not given patentable weight over the prior art. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP §2112.01. The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product. The chemical compounds in the compositions of US '275 are the same as those instantly claimed and, therefore, exhibit the same properties instantly claimed absent evidence to the contrary.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-12, 14-17, 24-26, 29 and 31-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,849,275 (275)

US '275 teaches all the limitations of the claims as stated in the 35 U.S.C. 102(b) rejection above. It does not teach a composition containing volatile silicone oils comprising groups of alkyl or alkoxy groups which can be pendant or at the end of the silicone chain (claims 4 and 7), the esters of claim 16 or the silicones of claim 24.

US '275 discloses volatile silicone oils containing alkyl groups as instantly claimed at column 4, lines 35-57. Alkyl octanoates (cetyl octanoate and tridecyl octanoate) and alkyl ricinoleates (cetyl ricinoleate) are disclosed at column 5, lines 27-33. Non-volatile silicone oils such as phenyltrimethicone are disclosed at column 5, line 58 to column 6, line 2.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of US '275 and add any one or combination of the non-volatile oils disclosed with the reasonable expectation of obtaining a cosmetic composition with improved transfer resistance.

6. Claims 1-17, 24-28 and 31-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 850 644 (644). US 6,177,091 (091) is used as an English language equivalent for citation purposes.

US '091 is directed to a cosmetic composition containing an organic polymer, a non-volatile oil (solvent) and a volatile oil (solvent). For organopolysiloxane polymers that may be partially or totally crosslinked in an amount from 0.3-40 wt.%, see column 2, lines 7-8 and 30-67. For crosslinked organopolysiloxane polymers that are disclosed by Applicant at page 7, last paragraph, see KSG® 6, KSG® 16, Trefil® E-505C and Trefil® E-506C at column 2, lines 51 to 60. For non-volatile oils that are the same substances as the instantly disclosed and claimed non-volatile solvents in an amount from 5-80 wt.%, see column 3, lines 9-52. For volatile oils that are the same substances as the instantly disclosed and claimed volatile solvents, see column 4, line 45 to column 5, line 24. US '091 discloses that when the non-volatile solvents make up 30-50 wt.% of the composition, the volatile solvents make up the remainder (col. 3, lines 49-52). The volatile solvents, therefore, can make up from 10-70 wt.% of the composition. For waxes, see column 3, line 53 to column 4, line 39. For dyes, antioxidants, essential oils, preserving agents, etc., see column 5, lines 25-34. For various forms of the composition such as solid and anhydrous gel, see column 2, lines 4-6 and claim 19. For application to keratin materials see column 7, lines 30-33.

US '091 does not explicitly teach a single composition containing at least one organic polymer capable of increasing in volume when deposited on keratin material, at least one non-volatile solvent and at least one volatile solvent or the functions of claims 40-42 and 45-47.

US '091 does teach that the compositions can contain both volatile and non-volatile oils. The oils disclosed in US '091 are the same oils disclosed by Applicant as

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suitable as the solvents. A composition containing the same components as instantly claimed would be expected to exhibit the same properties. US '091 teaches the same components as instantly claimed. It is reasonable for one of ordinary skill in the art to expect a composition of US '091 containing the same components as instantly claimed to exhibit the same properties such as effectiveness for the functions of claims 40-42 absent evidence to the contrary.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of US '091 containing both volatile and non-volatile solvents with the reasonable expectation of obtaining a composition that is gently to apply, spreads easily, is non-sticky and does not dry the skin or lips.

7. Claims 1-20, 22, 24-29 and 31-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 850 644 (US '091) in combination with US 5,851,517 (517).

US '091 teaches all the limitations as stated in the 35 U.S.C. 103(a) rejection above. It does not teach cyclic hydrocarbons (claims 18 and 19) or aromatic hydrocarbons (claims 20 and 22).

US '517 discloses cyclohexane as a solvent (col. 4, lines 28-29) and ester oils such as fatty acid benzoates (col. 3, lines 37-46) for use in cosmetic compositions.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of US '091 and add cyclohexane and/or a fatty acid benzoate for their art-recognized solvent properties.



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8. Claims 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over either US 5,849,275 (275) or EP 850 644 (US '091) as applied to claims above, and further in view of US 5,725,882 (882).

US '091 and US '275 each teach all of the limitations of the claims as stated in the 35 U.S.C. rejections above. They do not teach the aromatic alkenes of claim 21 or triethanolamine of claim 23.

US '882 is directed to cosmetic compositions (title). US '882 discloses at column 17, line 66 to column 18, line 9 that toluene is used as a solvent. Triethanolamine is disclosed at column 19, lines 58-63 as a neutralizer. Both of these substances are well known common additives in cosmetic compositions. The recited use of the substance does not render a composition containing that substance patentable over the prior art. The substance would be expected to provide the effect desired absent evidence to the contrary.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the cosmetic compositions of either US '091 or US '275 each and add toluene and/or triethanolamine as taught by US '882 for their art-recognized uses as a solvent and neutralizer, respectively.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leonard M. Williams whose telephone number is 571-272-0685. The examiner can normally be reached on MF 9-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LMW

S. Wang  
PATENT EXAMINER  
UNIT 1617